

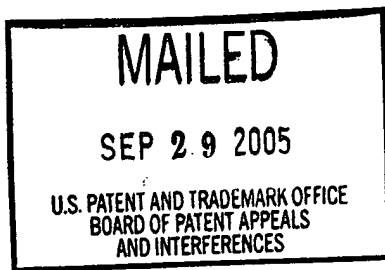
2005-1057

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte PAUL A. HOSIER, THOMAS GRIMSLEY, and JOSEF E. JEDLICKA



Appeal No. 2005-1057
Application No. 09/802,792

ON BRIEF

Before KRASS, CRAWFORD, and RUGGIERO, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 3 and 6 to 10 and 20 to 30. Claims 4, 5 and 33 have been canceled, claims 11 to 19 are allowable and claims 31 to 32 and 34 to 37 have been withdrawn from consideration.

We affirm.

BACKGROUND

The appellants' invention relates to a photosensitive chip for creating electrical signals for an original image (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Jedlicka et al. (Jedlicka)	5,604,362	Feb. 18, 1997
Koizumi et al. (Koizumi)	5,698,892	Dec. 16, 1997

The rejections

Claims 1, 6 to 10, 20, 22 to 24 and 26 to 30 stand rejected under U.S.C. § 102 as being anticipated by Koizumi.

Claims 2 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Koizumi.

Claims 3 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Koizumi in view of Jedlicka.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed November 18, 2003) for the examiner's complete reasoning in support of the

rejections, and to the brief (filed September 12, 2003) and reply brief (filed January 20, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the rejection of claims 1, 6 to 10, 20, 22 to 24 and 26 to 30 as anticipated by Koizumi. We note that to support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The examiner is of the view that Koizumi describes each element of claim 1 (see answer at page 4).

The appellants argue that Koizumi does not describe a photosensitive chip having a groove and a light-transmissive planar layer extending over the groove portion. In appellants' view because Koizumi teaches that the light-transmissive planar layer is removed before the chip is severed from the chip (col. 2, lines 64 to 68),

Koizumi does not describe this feature of claim 1. In appellants' view, the structure prior to the severing of the chip from the wafer is a wafer not a chip.

We do not find this argument persuasive because it is not commensurate with the actual scope of claim 1. Claim 1 recites a chip but does not recited a severed chip. Therefore, each of the chips of Koizumi prior to severance from the wafer is a chip that meets the requirements of claim 1. As these chips are depicted in Figure 11B to 11E to have a light transmissive planar layer in the groove 92, the requirements of claim 1 are met.

In view of the foregoing, we will sustain the rejection of claim 1. We will also sustain the rejection of claims 6 to 10, 20, 22 to 24 and 26 to 30 as these claims stand or fall with claim 1 because the appellants have not separately argued the patentability of these claims. Accordingly, we have determined that these claims must be treated as falling with their respective independent claim. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and 37 CFR §§ 1.192(c)(7) and 1.192(c)(8)(iv).

The appellants have not specifically argued the rejection of claims 2 , 12 and 21 under 35 U.S.C. § 103 as being unpatentable over Koizumi or the rejection of claims 3, 13 and 25 under 35 U.S.C. § 103 as being unpatentable over Koizumi in view of Jedlicka. In regard to these rejections the appellants rely on the arguments made in

The decision of the examiner is affirmed.

AFFIRMED


JOSEPH F. RUGGIERO
Administrative Patent Judge

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